



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/057,261 04/08/98 O'HAGAN

T TELNP0157US

023623 TM02/0730
AMIN ESCHWEILER & TUROCY, LLP
24TH FLOOR, NATIONAL CITY CENTER
1900 EAST 9TH STREET
CLEVELAND OH 44114

EXAMINER

KNEPPER, D

ART UNIT

PAPER NUMBER

2645

DATE MAILED:

07/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

MF

Office Action Summary

Application No.

09/057,261

Applicant(s)

O'HAGAN, TIMOTHY P.

Examiner

David D. Knepper

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5 and 8-22 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,2,4,5,8-18,20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant's correspondence filed on 18 May 2001 (paper #12 has been received and considered. Claims 1, 2, 4, 5, 8-18, 20 and 22 are pending. Claims 3, 6 and 7 were canceled by the applicant.
2. Claims 19 and 21 are withdrawn from consideration based on the previous conversation with Himanshu Main who elected without traverse to prosecute invention I as explained in the previous Office action (paper #10), items 1-4. The restriction requirement is now made **final**. A complete response must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP 821.01).

Title

3. The title is objected to because it is generic ; contains legalist language "method and system" which is only appropriate for the claims; and fails to describe the invention in a useful manner.

Claims

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4, 5, 8-18, 20 and 22 are rejected under 35 U.S.C. § 103 as being unpatentable over Barclay (5,960,399).

A "host computer", "mobile terminal", "dictionary file and syntax file" are anticipated by Barclay because these items are inherent in any use of the internet. Especially those that use HTTP and/or TCP/IP as the protocols upon which to share information between host and user (or as Barclay says, client, see figures 1, 4 and 6).

It is noted that Barclay does not anticipate "a GUI display file having attached thereto at least one of a dictionary file and syntax file . . . content specific to the GUI display file". However, he teaches that this is prior art technology performed by an Internet based speech recognition system called SAM which requires the speech recognizer software to reside at the client . . . the grammar is, in effect distributed and downloaded when a Web page for specific topics is entered . . . the vocabularies and grammars are small. This teaches that it was well known prior to 1996 to provide small grammars and vocabularies which are specific to a GUI such as are commonly known to exist on a web page for interaction at remote locations through common TCP, IP and HTTP protocols. It would have been obvious for a person having ordinary skill in the pertinent art, at the time the invention was made, to combine the limited capability of SAM noted above with the system of Barclay because Barclay explicitly teaches that he can perform speech recognition. Barclay improves upon such a limited system by also allowing speaker recognition but explains in his background sufficiently that one of ordinary skill in the art would know that a simplification such as using limited vocabulary (dictionary) and syntax (grammar) specific to a GUI would only yield expected results

that are well known in the art.

Comments

6. The arguments in paper #12 point out that Baji does not teach limited vocabulary and syntax that is explicitly limited to a GUI display file communicated between host and terminal. Claim language was added to implement this feature and is addressed in the rejection above based on Barclay.

7. **Any response to this action should be mailed to:**

Box AF
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

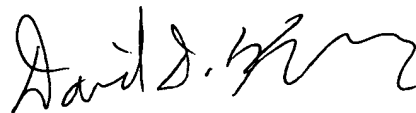
TC2600 Fax Center
(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Knepper whose telephone number is (703) 305-9644. The examiner can normally be reached on Monday-Thursday from 07:30 a.m.-6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

A handwritten signature in black ink, appearing to read "David D. Knepper", with a stylized flourish at the end.

David D. Knepper
Primary Examiner
Art Unit 2645
July 25, 2001